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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARKUS SCHEUBER and HANS FREI

Appeal 2007-3517
Application 09/876,760
Technology Center 2800

Decided: March 18, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and KARL
EASTHOM, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 5-14. Claims 1-4 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to a method and apparatus for providing text on a printed surface of a plurality of printed products which are conveyed in an overlapping imbricated stream to expose a border region of each printed product. A partially transparent contrast panel is printed onto the exposed border region of each printed product with the contrast panel forming a contrast with information formed within or on the contrast panel. (Specification 3-4).

Claim 5 is illustrative of the invention and reads as follows:

5. A method of providing text on a printed surface of each of a plurality of printed products comprising the steps of

conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap, while

printing a partially transparent contrast panel onto the exposed border region of each printed product, and while

forming information within or on each contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read.

The Examiner relies on the following prior art references to show unpatentability:

Gurwick	US 2,084,026	Jun. 15, 1937
Reist	US 4,538,161	Aug. 27, 1985
Mowry, Jr. (Mowry)	US 4,681,348	Jul. 21, 1987
Fröhlich	US 4,983,990	Jan. 8, 1991

Mike Benton (Benton), 1933: *The First Comic Book*, (1933),

http://www.comicbooklife.com/pag/benton/bentonCBA_1933.html (last visited Nov. 20, 2003).

Claims 5, 7, 8, 10, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mowry in view of Fröhlich.

Claims 6, 9, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mowry in view of Fröhlich and further in view of Gurwick.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mowry in view of Fröhlich and further in view of Reist.

Claims 5-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Benton in view of Fröhlich.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Benton in view of Fröhlich and further in view of Reist.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

(i) Under 35 U.S.C § 103(a), with respect to appealed claims 5, 7, 8, 10, 11, and 13, would one of ordinary skill in the art at the time of the

invention have found it obvious to combine Mowry and Fröhlich to render the claimed invention unpatentable?

(ii) Under 35 U.S.C § 103(a), with respect to appealed claims 6, 9, and 12, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Mowry and Fröhlich by adding the teachings of Gurwick to render the claimed invention unpatentable?

(iii) Under 35 U.S.C § 103(a), with respect to appealed claim 14, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Mowry and Fröhlich by adding the teachings of Reist to render the claimed invention unpatentable?

(iv) Under 35 U.S.C § 103(a), with respect to appealed claims 5-13, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Benton and Fröhlich to render the claimed invention unpatentable?

(v) Under 35 U.S.C § 103(a), with respect to appealed claim 14, would one of ordinary skill in the art at the time of the invention have found it obvious to modify the combination of Benton and Fröhlich by adding the teachings of Reist to render the claimed invention unpatentable?

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so

doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). “One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

ANALYSIS

I. *The combination of Mowry and Fröhlich* *Independent claim 5*

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claim 5 based on the combination of Mowry and Fröhlich, Appellants' arguments in response assert a failure to set forth a prima facie case of obviousness since the Examiner has not established a proper basis for the proposed combination of references. According to Appellants (App. Br. 5-8; Reply Br. 3-4), the subject matter of Mowry, which is directed to the alteration protection of financial documents, is non-analogous to the field of technology of the present invention, which is directed to the applying of address labels on printed products. In a related argument, Appellants contend (*id.*) that an individual working in the field of the printing of individual financial documents, such as in Mowry, would not look to the field of printing on documents conveyed in an imbricated stream such as in Fröhlich.

After reviewing the Mowry and Fröhlich references in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. Initially, we note that the test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Our review of the disclosures of Mowry and Fröhlich finds it apparent, as asserted by the Examiner (Ans. 9), that the cited references are both directed to the individual printing of information on printed products. In addition, Fröhlich provides a disclosure of automating the printing process by conveying the printed products past a printer in an overlapping imbricated stream as presently claimed.

We find no error in the Examiner's finding, for the reasons articulated by the Examiner (Ans. 5 and 10), that the ordinarily skilled artisan would have logically consulted the teachings of Fröhlich in attempting to solve problems associated with the printing of information on printed products such as in Mowry. We further agree with the Examiner's finding that the ordinarily skilled artisan would have recognized and appreciated that the overlapping imbricated conveying features disclosed therein would have served as an obvious enhancement to the printing system of Mowry, thereby enabling the individualized printing of information on printed products in an automated and efficient assembly line process. According to *Leapfrog*, when combination of familiar elements according to methods known to the skilled artisan, such as preventing the conducting material from forming filaments in the voids in dielectric layer, achieves a predictable result, it is likely to be obvious.

We also find to be unpersuasive Appellants' further argument attacking the basis for the Examiner's proposed combination of Mowry and Fröhlich which asserts (App. Br. 8) that the Mowry printing operation, which uses pressure sensitive frangible capsules that hold the ink forming

chemicals, is too expensive and unsuitable for use in printing on a conveyed stream of products such as in Fröhlich. We simply find no evidence forthcoming from Appellants that would support such a conclusion. Similarly, Appellants' contention (Reply Br. 3-4) that an impact printer, such as used by Mowry, would not be acceptable for use on printing on products conveyed in an imbricated stream is also not supported by the evidentiary record before us. The arguments of counsel cannot take the place of evidence in the record. *See In re Geisler*, 116 F.3d 1465, 1468 (Fed. Cir. 1997).

We further find Appellants' additional arguments, presented at pages 1-3 of the Reply Brief, to be without merit. Appellants' attempt to distinguish the presently claimed printing operation over the printing operation disclosed by Mowry is not commensurate with the scope of the claims since no particular printing method has been recited in the claims. Further, Mowry unambiguously describes (col. 1, ll. 49-58) the application of printed information 20 over the printed areas 30 and 40 of document 10 as "print produced by a printer." Further, Appellants' arguments to the contrary notwithstanding, we agree with the Examiner that, at the very least, the "dollar" panel area in Mowry, in which the dollar amount is negatively printed enabling the underlying printing to be seen, can be considered to be a partially transparent contrast panel as claimed.

In view of the above discussion, since the Examiner's *prima facie* case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of

independent claim 5, as well as dependent claim 7 not separately argued by Appellants.

Independent claim 8

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on the combination of Mowry and Fröhlich of independent claim 8, as well as dependent claim 10 not separately argued by Appellants. Independent claim 8 differs slightly from previously discussed independent claim 5 by including a limitation requiring that the partially transparent contrast panel "overlie" the printed information on the printed product. Referring to our previous discussion of Mowry in regard to independent claim 5, we find that, at the very least, the partially transparent contrast panel "dollar" area in Mowry overlies the underlying diagonally printed information which can be seen through the transparent number "8" dollar amount.

Independent claim 11

The Examiner's obviousness rejection of independent claim 11, based on the combination of Mowry and Fröhlich, as well as that of dependent claim 13 not separately argued by Appellants, is also sustained. Again referring to our earlier discussion with regard to the Mowry reference, we agree with the Examiner's finding that the printing operation in Mowry satisfies the printing features of independent claim 11. For example, we find

that Mowry (Figure 3 and col. 1, ll. 49-58) prints both the partially transparent contrast panel such as the negatively printed “8,” which allows the printed surface of the printed product to be seen, as well as the formation of the positively printed “EIGHT” within the transparent “8” portion.

Dependent claims 6, 9, and 12

We find nothing in Appellants’ arguments (App. Br. 9-10) which convinces us of any error in the Examiner’s stated obviousness rejection in which Gurwick is added to the combination of Mowry and Fröhlich to address the claimed feature of using a separate color printing operation to print information onto a contrast panel. Accordingly, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of these claims.

As described by Gurwick at page 3, left column, lines 9-21, information (the word “Candy”) is printed onto a contrast panel 16 using a third color which is different from the color of the contrast panel as well as the color of the tinted sheet 12. Appellants’ arguments in response attack Gurwick as not teaching the printing of a partially transparent contrast panel onto a printed product so that the underlying printed product can be seen. As previously discussed, however, the Examiner has relied upon Mowry, not Gurwick, for this feature. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F. 2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F. 2d 1091, 1097 (Fed. Cir. 1986).

Dependent claim 14

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of this claim in which the Reist reference has been added to the combination of Mowry and Fröhlich to address the conveyor clamp feature of this claim. Appellants have made no separate arguments as to the patentability of this claim and instead have relied upon the previous arguments attacking the Examiner's proposed combination of Mowry and Fröhlich, which arguments we found to be unpersuasive as discussed *supra*.

II. The combination of Benton and Fröhlich

We do not sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on the combination of Benton and Fröhlich, of claims 5-13, nor the 35 U.S.C. § 103(a) rejection of dependent claim 14, in which Reist is added to the combination of Benton and Fröhlich. We find ourselves in agreement with Appellants' contention (App. Br. 11-12; Reply Br. 4-5) that the "A Century of Comics" article authored by Benton does not disclose the printing of a partially transparent contrast panel onto a printed product in combination with the formation of information on or within the contrast panel, which features are present in each of the appealed independent claims 5, 8, and 11.

Although the Examiner has set forth (Ans. 7) an explanation as to how the printing of the four-color cover illustration of the Benton article would satisfy the claimed partially transparent contrast panel printing limitations, we find no basis in this illustrated figure, or elsewhere in the Benton

document, to support the Examiner's conclusion. We also find no disclosure in either Fröhlich or Reist, taken individually or collectively, which would overcome the deficiencies of Benton. In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

CONCLUSION

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of claims 5-13 based on the combination of Benton and Fröhlich, nor the 35 U.S.C. § 103(a) rejection of claim 14 in which Reist is added to the combination of Benton and Fröhlich. We have, however, sustained the Examiner's 35 U.S.C. § 103(a) rejection of claims 5-14, all of the claims on appeal, based on various combinations of Mowry, Fröhlich, Gurwick and Reist. Therefore, the decision of the Examiner rejecting claims 5-14 is affirmed.

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Application 09/876,760

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

tdl/gw

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